

REMARKS

Claims 1-9 are pending in this application. By this Amendment, the specification is amended. No new matter is added by this amendment. Reconsideration of the application in view of the above amendment and the following remarks is respectfully requested.

An Information Disclosure Statement is being filed with this Amendment. It is requested that the Examiner consider the references therein and return an initialed form PTO-1449 in the next Office Action.

The Office Action objects to the specification for informalities. The specification has been amended to overcome the objection based on the Examiner's helpful comment. Applicant respectfully requests that the objection to the specification be withdrawn.

The Office Action rejects claim 8 under 35 U.S.C. §112, first paragraph for failing to describe in detail the inner workings of the one-way clutch nor explaining how the clutch is laid out in relation to the various gears. In such a rejection, the burden of proof lies with the Examiner to show by a preponderance of the evidence why a person skilled in the art would not recognize in Applicant's disclosure a description of the invention defined by the claims. (MPEP - 2163.01 (III(A)), *Wertheim*, 541 F.2d at 263, 191 USPQ at 97).

Applicant is unable to find any evidence on page 2 of the Office Action as to why the Examiner believes Applicant has failed to describe the one-way clutch and its relation to the various gears in sufficient detail as to allow a person of ordinary skill in the art to recognize that Applicant invented what is claimed. (MPEP - 2163.01 (I)). How the gears are laid out is explained in Fig. 1 and paragraphs [0043]-[0045] of the specification. As for the inner workings of the one-way clutch, these features are conventional in the art or known to one of ordinary skill in the art. (MPEP - 2163.01 (I(A))). Because the Examiner has failed to meet his burden of proof and Applicant has described the one-way clutch sufficiently in light of

what is known to one of ordinary skill in the art, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claim 8 under 35 U.S.C. §112, first paragraph for failing to enable the starter drive mechanism. The test of enablement is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." (MPEP - 2164.01, *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8, USPQ2d 1217, 1223 (Fed. Cir. 1988).

Applicant finds no evidence on page 2 of the Office Action as to why the Examiner believes that Applicant has failed to enable the starter drive mechanism as claimed. As stated by the court, "it is incumbent upon the Patent Office, whenever rejection on this basis is made, to explain it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the Applicant to go to the trouble and expenses supporting his presumptively accurate disclosure." (MPEP - 2164.04, *In re Marzocchi*, 439 F.2d 224, 169 USPQ at 370).

Enablement for the starter drive mechanism can be found in Fig. 2 and paragraph [0047] of the specification. Combine this information with information known in the art and there is no undue experimentation needed to create the starter drive mechanism. Because the Examiner has failed to meet his burden of proof and Applicant had demonstrated that the specification read in light of what is known in the art would not cause undue experimentation to make the starter drive mechanism, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claims 1-7 and 9 under 35 U.S.C. §102(e) over U.S. Patent No. 6,786,212 to Choi. The rejections are respectfully traversed.

Claim 1 calls for an engine starting apparatus comprising a motor for transmitting a torque to an engine of a vehicle to rotate the engine; and a motor controlling device for prohibiting rotation of the motor if the engine runs in reverse rotation. Claim 9 calls for similar features. Choi fails to disclose these features because Choi fails to discuss a motor controlling device that prohibits rotation of the motor if the engine runs in reverse rotation.

The Office Action, on page 3, states that Fig. 1 teaches on Applicant's claim 1. Applicant is unable to find reference to a motor controlling device that prohibits rotation of the motor if the engine runs in reverse rotation. However, Fig. 1 does describe a controller that can stop an engine from running in reverse rotation by stopping fuel injection and/or ignition of the engine when the reverse rotation of the engine is detected (col. 2, lines 3-13, col. 3, lines 6-67, col. 4, lines 1-40 and claim 1). Because Choi fails to provide disclosure of a controlling device that prohibits rotation of the motor if the engine runs in reverse rotation, Choi fails to disclose all of the features of claims 1 and 9.

Applicant would like to point out that although claim 1 of Choi does disclose a determination of whether the motor has stopped, they fail to disclose the prohibition of the motor from rotating when the engine runs in reverse rotation. The fact that the motor is stopped in Choi is only informational and used in determining whether the engine is running in reverse rotation. Therefore, Choi fails to disclose all of the features of claims 1 and 9.

Accordingly, Applicant respectfully requests that the rejection be withdrawn.

The Office Action rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over Choi in view of U.S. Patent No. 6,637,398 to Suzuki et al. (hereinafter "Suzuki"). The rejection is respectfully traversed.

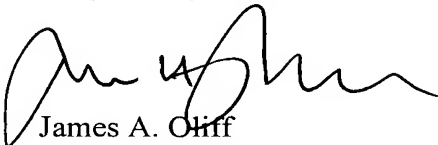
Suzuki fails to overcome the deficiencies of Choi in disclosing a motor controlling device for prohibiting rotation of said motor if the engine runs in reverse rotation.

Accordingly, Applicant respectfully requests that the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:RHR/mab

Attachment:
Information Disclosure Statement

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